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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,599	09/25/2003	Satoru Yamaguchi	461-147	1316

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NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER

RAO, G NAGESH

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/669,599	Applicant(s) YAMAGUCHI ET AL.	
	Examiner G. Nagesh Rao	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/1/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Arguments

Election/Restrictions

1. Newly submitted claim 17 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 17 is a method claim and could be operated by a different apparatus and furthermore the apparatus is seen as being capable of handling other materials such as plastic, therefore this method claim can not be examined with the current set of claims respected towards an apparatus.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 17 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

2. Claims 1-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Inoguchi (US PG Publication 2003/0098530) in view of Ito (US Patent No. 5,607,636 A).

The applicant is thanked for noting the use of the word “anticipated” in the previous office action. Examiner would like to clarify that the prior art deemed the claimed invention as being obvious to one skilled in the art.

Inoguchi 530 teaches a production method for ceramic structures including honeycombed structures. The apparatus shown in figure 1 of Inoguchi is a first screw extruder housing (31) containing an extrusion screw (35) leading materials downstream inside a second screw extruder housing (11) that is led to a molding die (8) used to form a ceramic molding, containing an extrusion screw (15) that processes said material toward die (8).

Inoguchi 530 however lacks the distinct screw extruder housed having a larger diameter head near the extruder’s head towards the molding die.

Examiner would like to take a moment and make note of applicant’s claim that although Ito’s extruder shown in the specification is being used for making plexifilamentary fiber, it does not mean that it could not be capable of handling ceramic materials. Materials worked upon in an apparatus are viewed as a recitation of intended use and bear no weight to the structural limitation of the apparatus.

In a method and apparatus related to extrusion molding, Ito 636’s extruder is comprised of shaft that is coaxial to a dulmage screw part as a first lead with

multiple threads in a spiral manner rotating integrally with its shaft body (figure 6 element 16) similar to that of the diffusion screw part. The screw in Ito 636 has a surface means that is capable of pressing said mixture compound through the extruder (an equivalent to claimed pressing screw part) with a rear lead with multiple threads forming a spiral ridge.

Ito 636's dumage screw part is of greater diameter to that of its pressing screw part as seen in figure 6 with the larger head in the front end of the screw and would be capable of acting as a diffusion screw part, where smaller well processed particles could flow through to the front portion of the extruder and the larger particles left behind to be mixed more thoroughly in the back portion of the screw before being led to the front and extruded into a molding die.

It would be inconceivable of a discontinuous screw and as shown in the prior art, all the screw extruders are continuous. Furthermore the spreading part between is interpreted as just being the backside of the front head of screw extruder. As seen in Ito 636's example in figure 6 there's the capability of the extruder having a spreading part behind the front head dumage screw portion.

Applicant's argue that Ito 636's screw extruder is remarkably different, but do not provide evidence as to how it is different nor incapable of handling ceramic materials.

Ito 636's screw extruder apparatus also would have the capability to knead and guide material toward a molding die if situated with one as shown in Inoguchi 530.

It would be obvious to one skilled in the art to modify the apparatus shown in Inoguchi 530 using the screw extruder shown in Ito 636, such that the material processed within the apparatus is thoroughly mixed at a more gradual consistent manner as it flows through the extruder (Column 22 Lines 25-59).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16 rejected under the judicially created doctrine of double patenting over the specification and claims 1-13 of U. S. Patent No. 6,790,025 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: First an apparatus related to ceramic molded extrusions is claimed in both applications, second the designs of both systems are very similar with respect to the drawings in the specification, third US patent 6,790,025 B2 appears to anticipate the language claimed in application 669,599.

First an apparatus related to ceramic molded extrusions is claimed in both the application and patent, second the designs of both systems are very similar with respect to the drawings in the specification, third the application 669,599 appears to be anticipated by the language claimed in patent 6,790,025 B2.

Essentially the molding apparatus claimed by applicant focuses on a screw extruder with a larger front head, an extruder known in the extrusion art as described earlier by the Ito 636 prior art reference. The same housing, extruders,

and processing means for molding materials from the device are disclosed in the prior patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant's arguments filed 3/1/2005 have been fully considered but they are not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

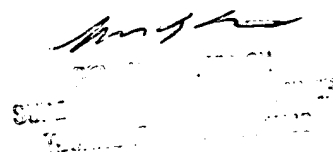
will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to G. Nagesh Rao whose telephone number is (571) 272-2946. The examiner can normally be reached on 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech can be reached on (571) 272-1137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GNR

A handwritten signature in black ink is positioned above a rectangular official stamp. The stamp contains the text "G. NAGESH RAO" and "Art Unit 1722" in a stylized, possibly embossed or printed font.

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